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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/758,143

01/15/2004

Dennis Michael Kazar

0901-0016

4625

33787

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03/28/2006

JOHN J. OSKOREP, ESQ.  
ONE MAGNIFICENT MILE CENTER  
980 N. MICHIGAN AVE.  
SUITE 1400  
CHICAGO, IL 60611

EXAMINER

NEGRON, ISMAEL

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 03/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/758,143

Applicant(s)

KAZAR ET AL.

Examiner

Ismael Negron

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendment filed on January 19, 2006 has been entered. Claims 1, 3, 5, 14 and 17-21 have been amended. No claim has been cancelled, or added. Claims 1-25 are still pending in this application, with claims 1, 8, 14 and 20 being independent.

### *Title*

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: ~~Year Round~~ Decorative Lights with Addressable Color-Controllable LED and Control Circuitry, and Method ~~Nodes for Selectable Holiday Color Schemes.~~

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over KRAMER (U.S. Pat. 3,789,211) in view of KAZAR (U.S. Pat. 5,008,595).

4. KRAMER discloses a decorative lighting system having:

- **a decorative light strand (as recited in Claim 1), Figure 5, reference numbers 20A-20C;**
- **the strand capable of being hanged by an end user (as recited in Claim 1), inherent;**
- **a plurality of addressable light sources (as recited in Claim 1), Figure 5, reference numbers 22A-22C;**
- **the light sources being color-controllable (as recited in Claim 1), column 4, lines 12-19;**
- **the light sources being red-green and blue light sources (as recited in Claim 1), column 4, lines 10-12;**
- **the light sources forming nodes along the decorative light strand (as recited in Claim 1), as seen in Figure 5;**
- **a control circuitry (as recited in Claim 1), as seen in Figure 3;**
- **the color scheme being associated with a holiday (as recited in Claim 1), column 3, line 28;**
- **the color scheme being associated with one or more different colors (as recited in Claim 1), column 3, lines 24-34;**

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- **the control circuitry sending the color data over one or more data lines to the light source nodes (as recited in Claim 1), column 3, lines 49-53;**
- **the control circuitry illuminating the light source nodes with a color scheme in response to a switch setting (as recited in Claim 1), as evidenced by Figure 3;**
- **at least some color schemes being associated with two or more different colors (as recited in Claim 7), column 4, lines 10-12; and**
- **the different colors being illuminated in a repeated interleaved pattern along the decorative light strand (as recited in Claim 7), column 4, lines 12-16.**

5. KRAMER discloses all the limitations of the claims, except:

- the light sources being light emitting diodes (as recited in Claim 1);
- the light emitting diodes (LED) being red-green-blue LED (as recited in Claim 1);
- a plurality of color schemes (as recited in claims 1 and 14);
- a decorating selector (as recited in Claim 1);
- the selector providing a plurality of user-selectable switch settings (as recited in Claim 1); and

- the control circuit selecting, from the memory, color data for a color scheme associated with a user-selectable switch setting (as recited in Claim 1).

6. KAZAR discloses a decorative lighting system having:

- **a decorative light strand (as recited in Claim 1), as seen in Figure 1;**
- **the strand capable of being hanged by an end user (as recited in Claim 1), inherent;**
- **a plurality of addressable light emitting diodes (as recited in Claim 1), as seen in Figure 15;**
- **the light emitting diodes (LED) being color-controllable (as recited in Claim 1), column 2, lines 53-57;**
- **the LED being red-green LED (as recited in Claim 1), as evidenced in column 2, lines 57-59;**
- **the light sources forming nodes along the decorative light strand (as recited in Claim 1), as seen in Figure 15;**
- **a control circuitry (as recited in Claim 1), as seen in Figures 9 and 10;**
- **a memory (as recited in Claim 1), inherent;**
- **the memory being for storing data for a plurality of color schemes (as recited in Claim 1), as evidenced in column 3, lines 3-12;**

- **each color scheme being associated with at least one holiday (as recited in Claim 1), as evidenced by column 1, lines 50-60;**
- **the color scheme being associated with at least one different color (as recited in Claim 1), column 2, lines 47-59;**
- **a decorating selector (as recited in Claim 1), as evidenced by column 3, lines 6-12;**
- **the selector providing a plurality of user-selectable switch settings (as recited in Claim 1), as evidenced by column 3, lines 6-12;**
- **each color-control switch being associated with a corresponding one of the plurality of colors**
- **the control circuit selecting, from the memory, color data for a color scheme associated with a user-selectable switch setting (as recited in Claim 1), as evidenced by column 5, lines 24-29;**
- **the control circuitry sending the color data over one or more data lines to the LED nodes (as recited in Claim 1), as seen in Figure 12; and**
- **the control circuitry illuminating the LED nodes with the color scheme in response to the user-selectable switch setting (as recited in Claim 1), as evidenced by column 3, lines 6-12.**

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of KRAMER and KAZAR to obtain a

decorative illumination device having a plurality of addressable RGB LED and control means capable of providing selectable color schemes, as per the teachings of both KRAMER (column 1, lines 24-54) and KAZAR (column 1, lines 31-68). In addition, the examiner takes Official Notice that the use of LEDs is old and well known in the illumination art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use LEDs as the light source in the system of KRAMER and KAZAR. One would have been motivated since LEDs are recognized in the illumination art to have many desirable advantages, including reduced size, high efficiency, low power consumption, long life, resistance to vibrations, and low heat production, over other light sources, as evidenced by KAZAR.

7. Regarding the claims use of the word "may", the applicant is respectfully advised that it has been held that the recitation that an element is capable of performing a function is not a positive limitation, but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

8. The applicant is further advised that, while the features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 44 USPQ2d 1429. In addition, it has been held by the courts that apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525 (Fed. Cir. 1990).



9. Claims 2-5 and 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over KRAMER (U.S. Pat. 3,789,211) in view of KAZAR (U.S. Pat. 5,008,595).

10. KRAMER and KAZAR disclose individually, or suggest in combination, all the limitations of the claimed invention, including:

- **a housing (as recited in Claim 5)**, inherent, as the disclosed circuit structures would necessarily require an enclosure;
- **the decorative light strand being capable of being attached to the housing (as recited in Claim 5)**, as evidenced by Figure 4 of KRAMER and Figure 1 of KAZAR; and
- **the control circuitry and the memory being located in the housing (as recited in Claim 5)**, inherent, as the circuit structures disclosed by both KRAMER and KAZAR would necessarily require an enclosure.

11. KRAMER and KAZAR disclose individually, or suggest in combination, all the limitations of the claimed invention, except:

- the plurality of holiday color schemes including at least four different U.S. holiday color schemes (as recited in Claim 2);
- a Christmas holiday color scheme having the colors red and green (as recited in claims 3 and 4);
- a Halloween holiday color scheme having the color orange (as recited in claims 3 and 4);

- an Independence Day holiday color scheme having the color white (as recited in Claim 3);
- an Independence Day holiday color scheme which consists of the colors red, white, and blue (as recited in Claim 4);
- a Valentine's Day holiday color scheme which includes the color red (as recited in Claim 4); and
- a St. Patrick's Day holiday color scheme which includes the color green (as recited in Claim 4).

12. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the claimed color schemes, since the courts have stated that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). In this case, KAZAR discloses a user-programmable controller 101 (Figure 2), programming such controller to produced a given light color scheme would have flown naturally to one of ordinary skill in the art as desired or necessitated by the specific requirements of a particular application.

13. Method claims 8-13 were considered as inherently disclosed, or suggested by the combined teachings of KRAMER and KAZAR (as detailed above).

14. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over KRAMER (U.S. Pat. 3,789,211) in view of KAZAR (U.S. Pat. 5,008,595) as applied to Claim 1 above, further in view of LOWE et al. (U.S. Pat. 6,424,096).

15. KRAMER and KAZAR disclose individually, or suggest in combination, all the limitations of the claimed invention, except a wireless receiver which is coupled to the control circuitry, and a wireless remote controller having the decorating selector which provides the plurality of user-selectable switch settings.

16. LOWE et al. discloses a decorative illumination device having:

- **a decorative light strand (as recited in Claim 1), Figure 1, reference number 10;**
- **the strand capable of being hanged by an end user (as recited in Claim 1), inherent;**
- **a control circuitry (as recited in Claim 1), as seen in Figure 2;**
- **a decorating selector (as recited in Claim 1), Figure 1, reference number 46;**
- **the selector providing a plurality of user-selectable switch settings (as recited in Claim 1), inherent;**
- **a wireless receiver (as recited in Claim 6), Figure 1, reference number 38;**
- **the receiver being coupled to the control circuitry (as recited in Claim 6), as seen in Figure 2;**

- **a wireless remote controller (as recited in Claim 6), Figure 1, reference number 44;**
- **the controller having the decorating selector (as recited in Claim 6), as seen in Figure 1.**

17. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to include the wireless remote controller/receiver structure of LOWE et al. into the decorative illumination apparatus of KRAMER and KAZAR, to provide such apparatus with means for remotely controlling and selecting a the illumination schemes, as per the teachings of LOWE et al. (see column 2, lines 44-54).

18. Claims 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over KRAMER (U.S. Pat. 3,789,211) in view of KAZAR (U.S. Pat. 5,008,595).

19. KRAMER discloses a decorative lighting system having:

- **a plurality of addressable light sources (as recited in Claim 14), Figure 5, reference numbers 22A-22C;**
- **the light sources being color-controllable (as recited in Claim 14), column 4, lines 12-19;**
- **the light sources being red-green and blue light sources (as recited in claims 14 and 16), column 4, lines 10-12;**
- **the light sources forming nodes along the decorative light strand (as recited in Claim 14), as seen in Figure 5;**

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- **a control circuitry (as recited in Claim 14), as seen in Figure 3;**
- **a memory (as recited in Claim 15), inherent;**
- **the memory being for storing data for a color schemes (as recited in Claim 15), inherent;**
- **the control circuitry illuminating the light source nodes with a color scheme in response to a switch setting (as recited in claims 14 and 17), as evidenced by Figure 3;**
- **at least some color schemes being associated with two or more different colors (as recited in claims 17 and 18), column 4, lines 10-12; and**
- **the different colors being illuminated in a repeated interleaved pattern along the decorative light strand (as recited in Claim 18), column 4, lines 12-16.**

20. KRAMER discloses all the limitations of the claims, except:

- the light emitting diodes (LED) being red-green-blue LED (as recited in Claim 14);
- a plurality of color schemes (as recited in Claim 14);
- a decorating selector (as recited in Claim 14);
- the selector providing a plurality of user-selectable switch settings (as recited in Claim 14);

- the control circuit selecting, from the memory, color data for a color scheme associated with a user-selectable switch setting (as recited in Claim 15); and
- the possible combinations of user-selectable switch providing color schemes corresponding to U.S. holidays including Christmas, Halloween, St. Patrick's Day, and Valentine's Day (as recited in Claim 19).

21. KAZAR discloses a decorative lighting system having:

- **a plurality of addressable light emitting diodes (as recited in Claim 14), as seen in Figure 15;**
- **the light emitting diodes (LED) being color-controllable (as recited in Claim 14), column 2, lines 53-57;**
- **the LED being red-green (RGB) LED (as recited in Claim 14), as evidenced in column 2, lines 57-59;**
- **the light sources forming nodes along the decorative light strand (as recited in Claim 14), as seen in Figure 15;**
- **a control circuitry (as recited in Claim 14), as seen in Figures 9 and 10;**
- **a decorating selector (as recited in Claim 14), as evidenced by column 3, lines 6-12;**

- **the selector providing a plurality of user-selectable switch settings (as recited in Claim 14), as evidenced by column 3, lines 6-12;**
- **each color-control switch being associated with a corresponding one of the plurality of colors (as recited in Claim 14), as evidenced by Figure 1;**
- **the control circuitry being operative to illuminate the RGB LED with a color scheme corresponding to the user-selectable switches (as recited in Claim 14), as evidenced by Figure 1;**
- **the control circuitry selecting the color scheme by identifying color data associated with a user-selectable switch (as recited in Claim 14), inherent, as the operation of the LED is controlled by the programming of the PAL IC;**
- **the control circuitry illuminating the RGB LED by sending color data over one or more data lines to the RGB LED (as recited in Claim 14), as evidenced by Figure 1;**
- **each color scheme being associated with at least one holiday (as recited in Claim 14), as evidenced by column 1, lines 50-60;**
- **the color scheme being associated with at least one different color (as recited in Claim 14), column 2, lines 47-59;**

- **the control circuitry selecting color data for a color scheme associated with a user-selectable switch setting (as recited in Claim 14), as evidenced by column 5, lines 24-29;**
- **the control circuitry sending the color data over one or more data lines to the LED nodes (as recited in Claim 14), as seen in Figure 12; and**
- **the control circuitry illuminating the LED nodes with the color scheme in response to the user-selectable switch setting (as recited in Claim 14), as evidenced by column 3, lines 6-12.**
- **a memory (as recited in Claim 15), inherent as it is required for the disclosed PAL IC to function;**
- **the memory being for storing data associated with the plurality of colors (as recited in Claim 15), as evidenced in column 3, lines 3-12;**
- **the plurality of colors including red, green, blue and white (as recited in Claim 16), as suggested in column 2, lines 55-59; and**
- **the possible combinations of user-selectable switch providing color schemes corresponding to U.S. holidays including Christmas, Halloween, St. Patrick's Day, and Valentine's Day (as recited in Claim 19), inherent, as it refers to desired functions programmed into the disclosed PAL IC.**



22. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of KRAMER and KAZAR to obtain a decorative illumination device having a plurality of addressable RGB LED and control means capable of providing selectable color schemes, as per the teachings of both KRAMER (column 1, lines 24-54) and KAZAR (column 1, lines 31-68). In addition, the examiner takes Official Notice that the use of LEDs is old and well known in the illumination art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use LEDs as the light source in the system of KRAMER and KAZAR. One would have been motivated since LEDs are recognized in the illumination art to have many desirable advantages, including reduced size, high efficiency, low power consumption, long life, resistance to vibrations, and low heat production, over other light sources, as evidenced by KAZAR.

23. The applicant is further advised that, while the features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 44 USPQ2d 1429. In addition, it has been held by the courts that apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525 (Fed. Cir. 1990).

24. Claims 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over KRAMER (U.S. Pat. 3,789,211) in view of KAZAR (U.S. Pat. 5,008,595) and LOWE et al. (U.S. Pat. 6,424,096).

25. KRAMER discloses a decorative lighting system having:

- **a decorative light strand (as recited in Claim 20), Figure 5, reference numbers 20A-20C;**
- **the strand capable of being hanged by an end user (as recited in Claim 20), inherent;**
- **a plurality of addressable light sources (as recited in Claim 20), Figure 5, reference numbers 22A-22C;**
- **the light sources being color-controllable (as recited in Claim 20), column 4, lines 12-19;**
- **the light sources being red-green and blue light sources (as recited in Claim 20), column 4, lines 10-12;**
- **the light sources forming nodes along the decorative light strand (as recited in Claim 20), as seen in Figure 5;**
- **a control circuitry (as recited in Claim 20), as seen in Figure 3;**
- **a memory (as recited in Claim 20), inherent;**
- **a housing (as recited in Claim 20), inherent;**
- **the control circuitry and the memory being located in the housing (as recited in Claim 20), inherent;**

- **the memory being for storing data for a color schemes (as recited in Claim 20), inherent;**
- **the color scheme being associated with a holiday (as recited in Claim 20), column 3, line 28;**
- **the control circuitry sending the color data over one or more data lines to the light source nodes (as recited in Claim 20), column 3, lines 49-53;**
- **the control circuitry illuminating the light source nodes with a color scheme in response to a switch setting (as recited in Claim 20), as evidenced by Figure 3;**
- **at least some color schemes being associated with two or more different colors (as recited in Claim 22), column 4, lines 10-12; and**
- **the different colors being illuminated in a repeated interleaved pattern along the decorative light strand (as recited in Claim 22), column 4, lines 12-16.**

26. KRAMER discloses all the limitations of the claims, except:

- the light sources being light emitting diodes (as recited in Claim 20);
- the light emitting diodes (LED) being red-green-blue LED (as recited in Claim 20);
- a plurality of color schemes (as recited in Claim 20);

- the color schemes including at least Christmas, Independence Day, Halloween, Valentine's Day and St. Patrick's Day (as recited in Claim 20);
- a decorating selector (as recited in Claim 20);
- the decorating selector having a keypad (as recited in Claim 20);
- the keypad providing a plurality of user-selectable switch settings (as recited in Claim 20);
- the control circuit selecting, from the memory, color data for a color scheme associated with a user-selectable switch setting (as recited in Claim 20);
- at least ten color schemes (as recited in Claim 20);
- the color schemes including at least two color schemes selected from the group consisting of Easter, Mardi Gras, and Cinco De Mayo (as recited in Claim 21);
- the color schemes include a plurality of sports team color schemes (as recited in Claim 23);
- the keypad being carried in the housing (as recited in Claim 24);
- a wireless receiver (as recited in Claim 25);
- the receiver being coupled to the control circuitry (as recited in Claim 25);
- a wireless remote controller (as recited in Claim 25); and
- the remote controller having the keypad (as recited in Claim 25).

27. KAZAR discloses a decorative lighting system having:

- **a decorative light strand (as recited in Claim 20), as seen in Figure 1;**
- **the strand capable of being hanged by an end user (as recited in Claim 20), inherent;**
- **a plurality of addressable light emitting diodes (as recited in Claim 20), as seen in Figure 15;**
- **the light emitting diodes (LED) being color-controllable (as recited in Claim 20), column 2, lines 53-57;**
- **the LED being red-green LED (as recited in Claim 20), as evidenced in column 2, lines 57-59;**
- **the light sources forming nodes along the decorative light strand (as recited in Claim 20), as seen in Figure 15;**
- **a control circuitry (as recited in Claim 20), as seen in Figures 9 and 10;**
- **a memory (as recited in Claim 20), inherent;**
- **the memory being for storing data for a plurality of color schemes (as recited in Claim 20), as evidenced in column 3, lines 3-12;**
- **each color scheme being associated with at least one holiday (as recited in Claim 20), as evidenced by column 1, lines 50-60;**

- **the color scheme being associated with at least one different color (as recited in Claim 20), column 2, lines 47-59;**
- **a decorating selector (as recited in Claim 20), as evidenced by column 3, lines 6-12;**
- **the selector providing a plurality of user-selectable switch settings (as recited in Claim 20), as evidenced by column 3, lines 6-12;**
- **the control circuit selecting, from the memory, color data for a color scheme associated with a user-selectable switch setting (as recited in Claim 20), as evidenced by column 5, lines 24-29;**
- **the control circuitry sending the color data over one or more data lines to the LED nodes (as recited in Claim 20), as seen in Figure 12; and**
- **the control circuitry illuminating the LED nodes with the color scheme in response to the user-selectable switch setting (as recited in Claim 20), as evidenced by column 3, lines 6-12.**

28. LOWE et al. discloses a decorative illumination device having:

- **a decorative light strand (as recited in Claim 20), Figure 1, reference number 10;**
- **the strand capable of being hanged by an end user (as recited in Claim 20), inherent;**
- **a control circuitry (as recited in Claim 20), as seen in Figure 2;**

- **a decorating selector (as recited in Claim 20), Figure 1, reference number 46;**
- **the decorating selector having a keypad (as recited in Claim 20), Figure 1, reference number 46;**
- **the keypad providing a plurality of user-selectable switch settings (as recited in Claim 20), inherent;**
- **a wireless receiver (as recited in Claim 25), Figure 1, reference number 38;**
- **the receiver being coupled to the control circuitry (as recited in Claim 25), as seen in Figure 2;**
- **a wireless remote controller (as recited in Claim 25), Figure 1, reference number 44;**
- **the controller having the decorating selector (as recited in Claim 25), as seen in Figure 1.**

29. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of KRAMER, KAZAR and LOWE et al. to obtain a decorative illumination device having a plurality of addressable RGB LED and control means capable of providing selectable color schemes, as per the teachings of both KRAMER (column 1, lines 24-54) and KAZAR (column 1, lines 31-68), such decorative illumination device having means for remotely controlling and selecting a the color schemes, as per the teachings of LOWE et al. (see column 2, lines 44-54). In addition, the examiner takes Official Notice that the use of LEDs is old and well known

in the illumination art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use LEDs as the light source in the system of KRAMER and KAZAR. One would have been motivated since LEDs are recognized in the illumination art to have many desirable advantages, including reduced size, high efficiency, low power consumption, long life, resistance to vibrations, and low heat production, over other light sources, as evidenced by KAZAR and LOWE et al..

30. Regarding the claimed invention having the claimed color schemes, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the claimed color schemes, since the courts have stated that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). In this case, KAZAR discloses a user-programmable controller 101 (Figure 2), programming such controller to produced a given light color scheme would have flown naturally to one of ordinary skill in the art as desired or necessitated by the specific requirements of a particular application.

#### ***Relevant Prior Art***

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



Dolan et al. (U.S. Pat. 4,455,562), Chaing (U.S. Pat. 4,713,586), Dowling et al. (U.S. Pat. App. Pub. 2002/0048169), Muller et al. (U.S. Pat. App. Pub. 2002/0057061), Lys et al. (U.S. Pat. App. Pub. 2002/0101197), Morgan et al. (U.S. Pat. App. Pub. 2002/0145394), Scanberger et al. (U.S. Pat. App. Pub. 2002/0195975), Blackwell (U.S. Pat. App. Pub. 2003/0028260), Piepgras et al. (U.S. Pat. App. Pub. 2003/0137258) and **Lys et al.** (U.S. Pat. 6,777,891) disclose various decorative illumination devices having a plurality of multicolored light source in addressable arrays, some also include programmable controllers for energizing the light sources in one of a plurality of patterns.

**Stinson** (U.S. Pat. 4,992,704) discloses a multicolor-LED having a red light die, a blue light die and a green light die within a single LED housing, capable of producing white light.

### ***Response to Arguments***

32. Applicant's arguments filed January 19, 2006 have been fully considered but they are not persuasive.

33. Regarding the Examiner's objection to the title, the applicant argues that the title suggested by the Examiner is less descriptive than the title as filed, as it further describes the claimed invention as being a year-round decorative apparatus having selectable holiday color schemes. However, the title as filed presents the subject matter of the invention as decorative light with color-controllable LED nodes, such

recitation implying that only the “LED nodes” are disclosed, such nodes capable of being controlled. In addition, the phrases “year-round” and “for selectable holiday color schemes” are related to the intended use of the subject matter of the invention, not its structure.

34. Regarding the Examiner’s rejection of Claim 1 under 35 U.S.C. 103(a) as being unpatentable over KRAMER (U.S. Pat. 3,789,211) in view of KAZAR (U.S. Pat. 5,008,595), the applicant argues that the cited reference fails to disclose all the features of the claimed invention, specifically “addressable color controllable RGB LED nodes”. The applicant further argues that the patented structure of KRAMER features only standard incandescent lamps, while the patented structure of KAZAR discloses bicolor LEDs. The applicant even further argues that the Examiner’s interpretation of the term “addressable” goes against the meaning as defined by not only in the specification, but also as commonly defined in the art.

35. In response to applicant’s arguments that KRAMER and KAZAR failed to disclose individually, or suggest in combination, a addressable color controllable RGB LED nodes the applicant is respectfully advised that while the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, 70 USPQ2d 1827 (Fed. Cir. May 13, 2004). In addition, applicant is strongly advised that one cannot show

nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In this case, as detailed in previous sections 3-8, the patented device of KRAMER features a light string 20 having plurality of multicolored light sources 22, each light source including a red light bulb 22A, a green light bulb 22B and a green light bulb 22C. The red, green and blue light bulbs are connected with control circuitry (as figures 3 and 4) in an arrangement broadly considered by the Examiner as an addressable circuit arrangement, since the control circuitry is capable of energizing each group of light bulbs 22A-C independently of one another.

The patented device of KAZAR discloses, as detailed in previous sections 3-8, a plurality of bi-color LEDs (as seen in Figure 15) arranged in an addressable circuit arrangement and controlled by a control circuitry (as seen in figures 9 and 10) capable of independently activating the LED to produce a plurality of different illumination patterns.

Combining the teachings of KRAMER and KAZAR would have flown naturally to one of ordinary skill in the art to increase the efficiency of the decorative illumination device and to provide such device with user-selectable color schemes.

36. Regarding the Examiner's rejection of Claim 1 under 35 U.S.C. 103(a) as being unpatentable over KRAMER (U.S. Pat. 3,789,211) in view of KAZAR (U.S. Pat. 5,008,595), the applicant argues that the cited references failed to suggest and provide

motivation for the proposed combination of features. The applicant further argues that modifying the patented device of KRAMER as suggest by the Examiner would go against the primary intent of KRAMER, as such device is disclose, according to the applicant, for producing special lighting effects with dynamically changing colored lights.

37. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See MPEP § 2144.

In this case, while the cited references themselves might, in arguendo, fail to suggest the combination proposed by the Examiner, one of ordinary skill in the art at the time the invention was made would have recognized its advantages based on the knowledge generally available in the art. As previously presented, the use of LEDs, and its advantages over specifically incandescent light sources (i.e. reduced size, high efficiency, low power consumption, long life, resistance to vibrations, and low heat production) is old and well known in the illumination art.

38. Regarding applicant's surprising arguments that the proposed modification would render the invention of KRAMER inoperative, the Examiner must strongly disagree. Combining the teachings of KAZAR with the structure of KRAMER would not (emphasis

added) prevent the modified structure from producing special lighting effects with dynamically changing colored lights, but would enable such modified structure to produced a plurality of different special lighting effects. In addition, it is noted that KRAMER specifically states the purposed of the invention as providing decorative lighting systems for Christmas trees and the like, of which dynamically changing colored light is but one example.

39. Regarding the Examiner's rejection of Claim 1 under 35 U.S.C. 103(a) as being unpatentable over KRAMER (U.S. Pat. 3,789,211) in view of KAZAR (U.S. Pat. 5,008,595), the applicant argues that the cited references failed to disclose, or even suggest, providing multiple holiday color schemes for year-round type lighting usage. The applicant further argues that the cited limitations are not related merely to matters of ornamentation, but rather concrete elements and their functionality for achieving a desired advantage.

40. In response to applicant's arguments that KRAMER and KAZAR failed to disclose individually, or suggest in combination, providing multiple holiday color schemes for year-round type lighting usage, the applicant is respectfully advised that, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

In this case, since the proposed combination of KRAMER and KAZAR disclose or suggest all the structural limitations of the claimed invention (as detailed in previous

sections 3-30), and such modified structure is capable of performing all the cited functions, using words such as “storing”, “selecting”, “sending” fail to further defined the structure of the claimed invention over the proposed combination of KRAMER and KAZAR.

### ***Conclusion***

41. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


42. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

43. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negrón whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached at (571) 272-2378. The facsimile machine number for the Art Group is (571) 273-8300.

44. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.

Ismael Negron  
Examiner  
AU 2875

  
Stephen Husar  
Primary Examiner